

Chung et al, has cut-out portions 66 in the flange which engage with the loop portion of the extension of spring 60. According to Chung et al the looped extension engages with cut-out portions 66 in the adjacent flange to prevent movement of spring 60 back and forth in directions 62 (See Fig. 3 of Chung et al), and the potential for disconnection of caster plate 44, and the caster from the caster pad.

It was emphasized by Applicants, the extended looped portion of spring member 60 running outside the perimeter of caster pad 50, according to Chung et al, is required to interact with the adjacent flange 52 to avoid unlocking and release of the spring member from the caster plate 44.

In contrast with Chung et al, neither embodiment of Kaneko's detachable caster plates have flanges adjacent to resilient stopper 16 (Embodiment of Fig. 1 of Kaneko) or tongue 46 (embodiment of Fig. 3 of Kaneko) needed to engage with spring 60, as required by Chung et al.

Finally, it was pointed out: Applicants' claim 1, as amended, provided the extension means having a length extending past the perimeter of the caster bracket is a non-flanged edge. As previously stated, operation of Chung et al's spring extension is dependent on the presence of an adjacent flange having cut-outs for interaction with the spring.

Most importantly, Kaneko does not utilize (or suggest) a caster plate having a flange at the edge adjacent to the locking means, so utilization of Chung et al's spring 60 on the caster plate of Kaneko would not be an appropriate substitution, especially in view of the omission of flange means required at the edge for locking spring 60 of Chung et al.

#### RESPONSE TO LATEST OFFICIAL ACTION

In the latest Official Action of August 22, 2005, the Examiner states at the bottom of page 3 of the Official Action : Chung et al are relied on solely for their teaching of the general concept of extending the flexible securing means past the periphery of the bracket; and not for replacing the securing means.

Applicants maintain this conclusion is improper and not in compliance with Office practices and guidelines, and a large body of supporting law on the subject. For example, **Section 2141 (page 2100-127) of the MPEP expressly provides :**

**THE PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS (COPY ATTACHED).**

The above statement from the MPEP means that in applying the prior art in rejecting claims, all teachings of the document must be considered as a whole, and one is not at liberty to exclude those that would lead away from the claimed invention.

In this connection, Chung et al also teach that operation of spring 60 is dependent on the presence of flange 52 having slots 66 which locks the spring, so the caster plate is flush against the caster pad to retain it in a locked position. In other words, without slotted flange 52, the spring 60 is subject to release itself, and therefore, is functionally inoperative.

Hence, successful use of spring 60 is dependent on the presence of a locking flange at the edge of the caster plate adjacent to edge where spring 60 extends. The problem is that the caster plates of Kaneko lack the necessary flange configuration to retain the spring 60. The Examiner is not at liberty to disregard such omissions because he wishes to rely only on a “general concept” of extending the flexible securing means past the periphery of the bracket.

Simply stated, the Examiner’s conclusion of obviousness was arrived at by disregarding certain fundamental teachings of Chung et al, which is in violation of Office guidelines set-forth in the MPEP, *supra*.

**SUMMATION**

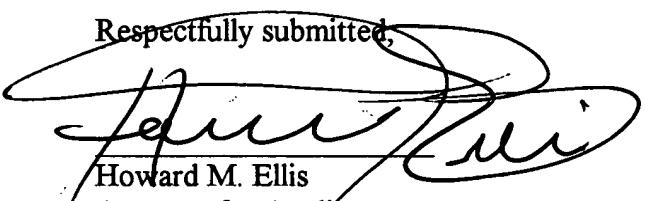
The one ground of rejection for reasons of obviousness, under 35 U.S.C. 103(a), over Kaneko in view of Chung et al, cannot stand because the rejection was not based on the entire teachings of the cited references. When the references are combined and the entire teachings of the art considered, Kaneko and Chung et al simply do not make out a *prima facie* case of obviousness. One is not at liberty in assessing patentability over the prior art to “pick and choose” only so much of the prior art that supports his position, to the exclusion of those portions that teach away, and negate the basis of the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-22 are

courteously requested.

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Respectfully submitted,



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## STANDARD OF PATENTABILITY TO BE APPLIED IN OBVIOUSNESS REJECTIONS

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy...

This in not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

The Supreme Court reaffirmed and relied upon the *Graham* three pronged test in its consideration and determination of obviousness in the fact situations presented in *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 189 USPQ 449, *reh'g denied*, 426 U.S. 955 (1976)

and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969). In each case, the Court discussed whether the claimed combinations produced a "new or different function" and a "synergistic result," but it clearly decided whether the claimed inventions were nonobviousness on the basis of the three-way test in *Graham*. Nowhere in its decisions in these cases does the Court state that the "new or different function" and "synergistic result" tests supersede a finding of nonobvious or obviousness under the *Graham* test.

Accordingly, examiners should apply the test for patentability under 35 U.S.C. 103 set forth in *Graham*. See below for a detailed discussion of each of the *Graham* factual inquiries. It should be noted that the Supreme Court's application of the *Graham* test to the fact circumstances in *Ag Pro* was somewhat stringent, as it was in *Black Rock*. Note *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F.2d 963, 200 USPQ 769 (7th Cir. 1979). The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983) that

A requirement for "synergism" or a "synergistic effect" is nowhere found in the statute, 35 U.S.C. When present, for example in a chemical case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness. The more objective findings suggested in *Graham*, *supra*, are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103. *Bowser Inc. v. United States*, 388 F.2d 346, 156 USPQ 406 (Ct. Cl. 1967).

## BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

1993). See MPEP § 2112 for the requirements of rejections based on inherency.

#### PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (Claims were directed to a process of producing a porous article by expanding shaped, unsintered, highly crystalline poly(tetrafluoroethylene) (PTFE) by stretching said PTFE at a 10% per second rate to more than five times the original length. The prior art teachings with regard to unsintered PTFE indicated the material does not respond to conventional plastics processing, and the material should be stretched slowly. A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE would not suggest rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly.).

#### 2141.03 Level of Ordinary Skill in the Art [R-2]

##### FACTORS TO CONSIDER IN DETERMINING LEVEL OF ORDINARY SKILL

"Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984).

The "hypothetical 'person having ordinary skill in the art' to which the claimed subject matter pertains

would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art." *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988) (The Board disagreed with the examiner's definition of one of ordinary skill in the art (a doctorate level engineer or scientist working at least 40 hours per week in semiconductor research or development), finding that the hypothetical person is not definable by way of credentials, and that the evidence in the application did not support the conclusion that such a person would require a doctorate or equivalent knowledge in science or engineering.).

References which do not qualify as prior art because they postdate the claimed invention may be relied upon to show the level of ordinary skill in the art at or around the time the invention was made. *Ex parte Erlich*, 22 USPQ 1463 (Bd. Pat. App. & Inter. 1992). >Moreover, documents not available as prior art because the documents were not widely disseminated may be used to demonstrate the level of ordinary skill in the art. For example, the document may be relevant to establishing "a motivation to combine which is implicit in the knowledge of one of ordinary skill in the art." *National Steel Car Ltd. v. Canadian Pacific Railway Ltd.*, 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004)(holding that a drawing made by an engineer that was not prior art may nonetheless "be used to demonstrate a motivation to combine implicit in the knowledge of one of ordinary skill in the art").<

##### SPECIFYING A PARTICULAR LEVEL OF SKILL IS NOT NECESSARY WHERE THE PRIOR ART ITSELF REFLECTS AN APPROPRIATE LEVEL

If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).